

10 Rejected

15 MAY 2002



UNITED STATES PATENT AND TRADEMARK OFFICE

 Commissioner for Patents, Box PCT  
 United States Patent and Trademark Office  
 Washington, D.C. 20231  
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U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/030,015	Masayoshi Maki	56687(71526)

INTERNATIONAL APPLICATION NO.	
PCT/JP00/04361	
LA FILING DATE	PRIORITY DATE
06/30/2000	07/01/1999

 21874  
 DIKE, BRONSTEIN, ROBERTS AND CUSHMAN,  
 INTELLECTUAL PROPERTY PRACTICE GROUP  
 EDWARDS & ANGELL, LLP.  
 P.O. BOX 9169  
 BOSTON, MA 02209

 CONFIRMATION NO. 7186  
 371 FORMALITIES LETTER


\*OC000C00007658333\*

Date Mailed: 03/19/2002

### NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as an Elected Office (37 CFR 1.495):

- U.S. Basic National Fees
- Priority Document
- Copy of IPE Report
- Copy of references cited in ISR
- Copy of the International Application
- Copy of the International Search Report
- Information Disclosure Statements
- Request for Immediate Examination

*U.S. Missing Parts*  
 Edwards & Angell LLP

 Dike, Bronstein, Roberts & Cushman  
 101 Federal St. Boston, MA 02110
Date Rec'd 3/25/02Docketed For May 19 - Sep 19, 2002By KIRApproved /

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.
- \$130 Surcharge for providing the oath or declaration later than the appropriate 30 months from the priority date (37 CFR 1.492(e)) is required.

**ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTH FROM THE DATE OF THIS NOTICE OR BY 22 or 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

## SUMMARY OF FEES DUE:

Total additional fees required for this application is **\$130** for a Large Entity:

- **\$130** Late oath or declaration Surcharge.

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

CHRISTINE S WASHINGTON

Telephone: (703) 305-3752

## PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/030,015	PCT/JP00/04361	56687(71526)

FORM PCT/DO/EO/905 (371 Formalities Notice)

Practitioner's Docket No. 56687 (71526)

## IN THE UNITED STATES DESIGNATED OFFICE (DO/US)

<u>PCT/IP00/04361</u>	<u>30 June 2000</u>	<u>01 July 1999</u>
INTERNATIONAL APPLICATION NO.	INTERNATIONAL FILING DATE	PRIORITY DATE CLAIMED

ADHESIVE PREPARATION FOR PERCUTANEOUS ABSORPTION  
TITLE OF INVENTION

Masayoshi MAKI and Yasuhiro IKEURA  
APPLICANT(S) FOR DO/US

**Box PCT**  
**Assistant Commissioner for Patents**  
**Washington, D.C. 20231**  
**ATTENTION: DO/US**

**COMPLETION OF FILING REQUIREMENTS  
FOR INTERNATIONAL APPLICATION ENTERING NATIONAL  
STAGE IN U.S. DESIGNATED OFFICE (DO/US) UNDER 35 U.S.C. 371**

*(check and complete the following item, if applicable)*

- ☒ This replies to the Notice of Missing Requirements under 35 U.S.C. § 371 and 37 C.F.R. 1.494 (FORM PCT/DO/EO/905).  
☒ A copy of FORM PCT/DO/EO/905 accompanies this response.

**WARNING:** *Filing requirements, including translation of the international application, the declaration, the national fee and the payment of all the surcharge(s) in connection with the filing of these items after twenty (20) months from the priority may be met within twenty-two (22) months from the priority date. Failure to comply with these requirements will result in abandonment. The provisions of 37 CFR 1.136 for extensions of time do not apply to the 22 month period. 37 CFR 1.61(b).*

**CERTIFICATION UNDER 37 C.F.R. 1.10\***  
*(Express Mail label number is mandatory.)*  
*(Express Mail certification is optional.)*

I hereby certify that this Completion of Filing Requirements and the papers indicated as being transmitted therewith is being deposited with the United States Postal Service on this date May 15, 2002, in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number EY097154682US, addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231.

Susan M. Dillon  
*(type or print name of person mailing paper)*

Susan M. Dillon  
Signature of person mailing paper

**WARNING:** *Certificate of mailing (first class) or facsimile transmission procedures of 37 C.F.R. 1.8 cannot be used to obtain a date of mailing or transmission for this correspondence.*

**\*WARNING:** *Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. 1.10(b).  
"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.*

**NOTE:** The completion of the filing requirements within 22 months (instead of 20 months) from the priority date results from the Commissioner exercising his judgment under the authority granted under 35 USC 371(d). The filing receipt will show the actual date of receipt of the last item completing the entry into the national phase. See 37 CFR 1.491 which states: "An international application enters the national stage when the applicant has filed the documents and fees required by 35 USC 371(c) within the periods set forth in § 1.494 and § 1.495."

**WARNING:** Where the items being submitted to complete the entry of the international application into the national phase are subsequent to 20 months from the priority date, the application is still considered to be in the international stage. If mailing procedures are utilized to obtain a date, the express mail procedure of 37 CFR 1.10 must be used (because international application papers are not covered by an ordinary certificate of mailing, 37 CFR 1.8(2)(xi)).

**NOTE:** Documents and fees must be clearly identified as a submission to enter the national stage under 35 USC 371. Otherwise, the submission will be considered as being made under 35 USC 111. 37 CFR 1.494(f).

## DECLARATION OR OATH

- I. ☒ No original declaration or oath was filed. Enclosed is the original declaration or oath for this application.

**NOTE:** For surcharge fee for filing declaration after filing date, complete item IV(2).

**NOTE:** Acceptable minimums in the declaration in an ordinarily filed U.S. application for identification of the specification to which it applies are the name of the inventor and (1) serial number, (2) attorney docket number that was on the application as filed and the filing date, (3) title of the invention and filing date, (4) title of invention and reference to a specification that is attached to the declaration at the time of execution and filed with the declaration, or (5) title of invention and a statement by a registered attorney that the application filed in the PTO is the application that the inventor executed by signing the declaration. If identification (4) is used, it must be accompanied by a statement that the "attached" specification is a copy of the specification and any amendments thereto that were filed in the PTO to obtain the filing date. Such a statement must be a verified statement if made by a person not registered to practice before the PTO. Notice of September 12, 1983 (1035 O.G. 3).

**NOTE:** Another minimum found acceptable in the declaration is the filing date (i.e., date of express mail) and the express mail number, useful where the serial number is not yet known. But note the practice where the express mail deposit is a Saturday, Sunday or holiday within the District of Columbia. 37 CFR 1.10(c).

**NOTE:** 37 CFR 1.41(a) points out that "Full names must be stated, including the family name and at least one given name without abbreviation together with any other given name or initial."

(complete (a) or (b), if applicable)

Attached is a

- (a) ☐ Statement by a registered attorney that the application filed in the PTO is the application that the inventor executed by signing the declaration.
- (b) ☐ Statement that the "attached" specification is a copy of the specification and any amendments thereto that were filed in the PTO to obtain the filing date.

## AMENDMENT

II. (complete as applicable)

- ☐ An amendment in accordance with 37 C.F.R. § 1.121 is attached.
- ☐ The attached amendment cancels claims \_\_\_\_\_ inclusively.

III. [ ] Submitted herewith, is a English translation of the non-English language international application papers as originally filed. It is requested that this translation be used as the copy for examination purposes in the PTO. (See 37 CFR 1.494(b)(2)).

**NOTE:** Unlike the filing of an ordinary non-English application (37 CFR 1.52(d)) the translation of an international application entering the U.S. national phase need not be verified. 37 CFR 1.494(e). If necessary, however, a verified translation may be required. 37 CFR 1.494(e). Moreover, if the English translation is filed within 20 months from the priority date, no processing fee is required.

## IV.

### 1. Fees for claims

- |     |  |          |
|-----|--|----------|
| [ ] | Each independent claim in excess of 3<br>(37 CFR 1.492(b) \$78.00; Small entity—\$39.00) | \$ _____ |
| [ ] | Each claim in excess of 20<br>(37 CFR 1.492(c) - \$18.00; small entity—\$9.00)           | \$ _____ |
| [ ] | Multiple dependent claim(s)<br>(37 CFR 1.492(d) - \$280.00;<br>small entity—\$140.00)    | \$ _____ |

2. Surcharge fees  
☒ Surcharge set forth in § 1.492(e), for accepting the declaration later than 20 months after the priority date in filing an application in the U.S. as a designated office— \$130.00; small entity—\$65.00 \$ 130.00

3. [ ] Processing fee set forth in § 1.492(f), for acceptance of an English translation later than 20 months after the priority date—\$130.00 \$ \_\_\_\_\_

7. [X] Assignment (See "ASSIGNMENT COVER SHEET".) \$ 40.00

Total fees            \$ 170.00

130.00 OP

## SMALL ENTITY STATUS

V. A statement that this filing is by a small entity

NOTE: See 37 CFR 1.28(a).

*(check and complete applicable items)*

- a. ☐ is attached.  
was filed on \_\_\_\_\_ (original).  
b. ☐ A separate refund request accompanies this paper.

## EXTENSION OF TIME

*(complete (a) or (b), as applicable)*

VI.

The proceedings herein are for a patent application. The provisions of 37 C.F.R. § 1.1 36(a) apply.

- (a) ☐ Applicant petitions for an extension of time, the fees for which are set out in 37 C.F.R. § 1.17(a)(1)-(4), for the total number of months checked out below:

Extension (months)	Fee for over than small entity _____	Fee for small entity
<input type="checkbox"/> one month	\$ 110.00	\$ 55.00
<input type="checkbox"/> two months	\$ 400.00	\$200.00
<input type="checkbox"/> three months	\$ 920.00	\$460.00
<input type="checkbox"/> four months	\$1,440.00	\$720.00

Fee \$ \_\_\_\_\_

If an additional extension of time is required, please consider this a petition therefore.

*(check and complete the next item, if applicable)*

- ☐ An extension for \_\_\_\_\_ months has already been secured. The fee paid therefor of \$ \_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ \_\_\_\_\_.

or

- (b) ☒ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

## TOTAL FEE DUE

**VII.** The total fee due is:

Completion fee(s) \$ 170.00  
Extension fee (if any) \$ \_\_\_\_\_  
  
TOTAL FEE DUE \$ 170.00

## PAYMENT OF FEES

**VIII.**

☒ Enclosed is a check in the amount of \$ \$170.00.  
☐ Charge Account No. \_\_\_\_\_ in the amount of \$ \_\_\_\_\_.  
A duplicate of this request is attached.

*NOTE: Fees should be itemized in such a manner that it is clear for which purpose the fees are paid. 37 CFR 1.22(b).*

## AUTHORIZATION TO CHARGE ADDITIONAL FEES

**IX.**

**WARNING:** Accurately count claims, especially multiple dependent claims, to avoid unexpected high charges.

*NOTE: "A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in § 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission." 37 CFR 1.136(a)(3).*

*NOTE: "Amounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amounts; amounts over twenty-five dollars may be returned by check or, if requested, by credit to a deposit account." 37 CFR 1.26(a).*

- ☒ The Commissioner is hereby authorized to charge the following additional fees that may be required by this paper, and during the entire pendency of this application, to Account No. 04-1105
- ☒ 37 C.F.R. 1.492(a)(2), 1.492(a)(3), or 1.492(a)(5) (filing fees)
- ☒ 37 C.F.R. 1.492(b) (presentation of extra claims)

*NOTE: Because additional fees for excess or multiple dependent claims not paid on filing, or on later presentation, must only be paid, or these claims cancelled by amendment prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency (37 CFR 1.16(d)), it might be best not to authorize the PTO to charge additional claim fees, except possibly when dealing with amendments after final action.*

- ☒ 37 C.F.R. 1.17 (application processing fees)
- ☒ 37 C.F.R. 1.17(a)(1)-(5)(extension fees pursuant to § 1.136(a).

**WARNING:** While 37 CFR 1.17(a), (b), (c) and (d) deal with extensions of time under § 1.136(a), this authorization should be made only with the knowledge that: "Submission of the appropriate extension fee under 37 CFR 1.136(a) is to no avail unless a "quest or petition for extension is filed." (Emphasis added). Notice of November 5, 1985 (1060 O.G. 27).

- ☐ 37 C.F.R. 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 C.F.R. 1.311 (b)).

NOTE: Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the notice of allowance. 37 CFR 1.311(b).

NOTE: 37 CFR 1.28(b) requires "Notification of any change in loss of entitlement to small entity status must be filed in the application . . . prior to paying, or at the time of paying . . . issue fee." From the wording of 37 CFR 1.28(b): (a) notification of change of status must be made even if the fee is paid as "other than a small entity" and (b) no notification is required if the change is to another small entity

[ ] 37 C.F.R. 1.492(e) and (f) (surcharge fees for filing the declaration and/or an English translation of an international application later than 20 months from the earliest claimed priority date)

WARNING: It is suggested that you always check this last authorization.

Reg. No. 38,256

Tel. No.: (617) 439-4444

Customer No. 21874

Christine C. O'Day  
SIGNATURE OF PRACTITIONER

Christine O'Day  
(type or print name of practitioner)

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